

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 10/078,392
ATTORNEY DOCKET NO. Q68601

REMARKS

Applicants thank the Patent Office for acknowledging Applicants' claim to foreign priority. Applicants request that the Patent Office indicate that the certified copy of the priority document, European Patent Application No. 01440076.6 dated March 16, 2001, has been received and made of record in the file.

Applicants thank the Patent Office for initialing the references listed on the PTO/SB/08 A & B form submitted with the Information Disclosure Statement filed on February 21, 2002 and returning an initialed copy of the PTO/SB/08 A & B form, thereby confirming that the listed references have been considered.

The Patent Office objects to the Drawings under 37 C.F.R. § 1.83(b) as allegedly being incomplete. The Patent Office indicates that new drawings for Figures 1-4, 7, 8 and 12 are required because structures and elements must be labeled.

With respect to Figures 1, 3 and 4, Applicant submits that these Figures are adequately labeled. For example, there is no difference between the labeling of Figures 5, 6, 9 and 10 and Figures 1, 3 and 4, and Figures 5, 6, 9 and 10 were not indicated as requiring corrected Drawings. Applicants respectfully request withdrawal of the § 1.83(b) objection to Figures 1, 3 and 4.

With respect to Figures 2, 7, 8, 11 and 12, Applicants herein provide corrected Drawings. Reference legends have been provided to Figures 2, 7, 8, 11 and 12 in accordance with the specification. No new matter has been added. Applicants submit that the § 1.83(b) objection to Figures 2, 7, 8 and 12 has been overcome, and respectfully request withdrawal of same.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 10/078,392
ATTORNEY DOCKET NO. Q68601

AMENDMENTS TO THE DRAWINGS

With respect to Figures 2, 7, 8, 11 and 12, Applicants herein provide corrected Drawings.

Attachment: Nine (9) Replacement Sheets

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 10/078,392
ATTORNEY DOCKET NO. Q68601

Applicants herein amend the specification to conform to the Replacement Sheets of drawings. The amendments to the specification are based on the drawings of the priority document European Patent Application No. 01440076.6. No new matter has been added. Entry and consideration of the amendments to the specification is respectfully requested.

Claims 1-13 have been considered on their merits.

Applicants herein cancel claims 4, 8, 11 and 12 without prejudice and/or disclaimer.

Applicants herein add new claims 14-21. Support for new claims 14-21 can be found in the originally filed specification and claims. Entry and consideration of the new claims 14-21 is respectfully requested.

Claims 1, 2, 3, 5, 6, 7, 9, 10 and 13-21 are all the claims presently pending in the application.

1. Claim 4 stands rejected under 35 U.S.C. § 112 (1st para.) as allegedly failing to comply with the enablement requirement. The rejection of claim 4 is now moot due to its cancellation.

2. Claims 7 and 10-12 stand rejected under 35 U.S.C. § 112 (2nd para.) as allegedly being indefinite. The rejection of claim 11 and 12 is now moot due to their cancellation. Applicants traverse the rejection of claims 7 and 10 for at least the reasons discussed below.

Applicants herein amend claims 7 and 10 to recite that a portion of the optical power of the received optical packets is forwarded to a first output and the remaining portion of the optical power of the received optical packets is forwarded to a second output. Applicants submit that

the § 112 (2nd para.) rejection of claims 7 and 10 has been overcome, and respectfully request withdrawal of same.

3. Claims 1, 2, 3, 5, 12 and 13 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Milton *et al.* (U.S. Patent No. 6,556,321). The rejection of claim 12 is now moot due to its cancellation. Applicants traverse the rejection of claims 1, 2, 3, 5 and 13, and insofar as the rejection might apply to new claims 14-21, for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). A proper anticipation rejection requires that every element of the claim be found “in a single prior art reference.” *See In re Robertston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Milton *et al.* fail to teach or suggest at least a load balancing stage that manages traffic levels of optical packets to prevent overloading by shifting selected packets from one multiwavelength band group to another multiwavelength band group, as recited in claim 1. The

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 10/078,392
ATTORNEY DOCKET NO. Q68601

cross-connect (15) shown in Figure 3 of Milton *et al.* merely connects between different wavelength bands. There is not teach or suggestion that the cross-connect (15) of Milton *et al.* manages traffic levels of optical packets to prevent overloading.

Based on the foregoing reasons, Applicants submit that Milton *et al.* fail to teach or suggest all of the claimed elements as arranged in claim 1. Thus, Applicants submit that claim 1 allowable, and further submit that claims 2, 3 and 5 and new claims 14-17 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Patent Office withdraw the § 102(b) rejection of claims 1, 2, 3 and 5.

Since claim 10 depends from claim 1, and there are no art-based rejections pending against claim 10, Applicants submit that claim 10 is allowable, at least by virtue of their dependency from claim 1

With respect to independent claim 13, Applicants submit that claim 13 is allowable for at least reasons analogous to those discussed above with respect to claim 1. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 13 is allowable, and further submit that new claims 18-21 are allowable as well, at least by virtue of their dependency from claim 13. Applicants respectfully request that the Patent Office withdraw the § 102(b) rejection of claim 13.

4. Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Milton *et al.* in view of Sotom *et al.* (U.S. Patent No. 5,796,501). Applicants traverse the rejection of claim 6 for at least the reasons discussed below.

Since claim 6 depends upon claim 1 and since Sotom *et al.* does not cure the deficient teachings of Milton *et al.* with respect to claim 1 (*i.e.*, the lack of any teaching or suggest at least with respect to a load balancing stage that manages traffic levels of optical packets to prevent overloading), Applicants submit that claim 6 is allowable at least by virtue of its dependency from claim 1. Thus, Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 6.

5. Claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Engell *et al.* (U.S. Patent No. 6,590,681) in view of Tanaka *et al.* (U.S. Patent No. 6,512,613). Applicants traverse the rejection of claim 7 for at least the reasons discussed below.

The Patent Office objects to claims 8 and 9 as being dependent upon a rejected base claim. Applicants have included the recitations of cancelled claim 8 in independent claim 7. Applicants submit that the § 103(a) rejection of claim 7 has been overcome, and respectfully request withdrawal of same.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 10/078,392
ATTORNEY DOCKET NO. Q68601

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

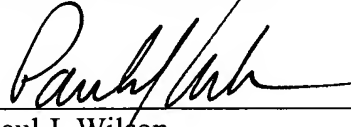
WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: April 25, 2005

Respectfully submitted,


Paul J. Wilson
Registration No. 45,879